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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,584	12/04/2000	Horst Grafe	HM-349 PCT	5053
7590	05/05/2004		EXAMINER	
Friedrich Kueffner 317 Madison Avenue Suite 910 New York, NY 10017			ASHLEY, BOYER DOLINGER	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 05/05/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/623,584	GRAFE ET AL.	
Examiner	Art Unit		
Boyer D. Ashley	3724		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 17 February 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 14-28 is/are pending in the application.  
4a) Of the above claim(s) 22-26 and 28 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 14-21 and 27 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_  
4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

1. In view of the appeal brief filed on 2/17/04, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "coiler" (claim 27) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 14-16 and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Russell et al., U.S. Patent 4,159,661.

Russell et al. discloses the same invention as claimed including: drums (15) and (20) with cutting tools (17 and 22); at least one driving device for accelerating the cutting tools to a peripheral speed corresponding to a speed of the strip (column 3, lines 20-40); a separately controllable adjusting device (28/35) for one of the drums, wherein one of the drums is mounted on rockers (33 or 39); wherein the adjusting device is comprised of drives for effecting a cutting movement (35, see column 4, lines 41-55) and support elements (39) for the rockers, wherein the support elements are shortenable to an effective position for effecting cuts. It should be noted that "shortenable" does not imply any specific type of shortening. In this case, the adjustment 28 causes a "shortening" that effects the cutting position of the blade 22.

As to claim 15, the support elements are mounted between the drives (35 and 28) for effecting the cutting movement.

As to claim 16, the support elements have an effective length, which is lockable by leaving the adjustment device (30) in position.

As to claim 18, Russell et al. discloses the use of a piston-cylinder unit (35).

As to claim 19, Russell et al. discloses the use of the drives being synchronized (see column 3, lines 24-45).

As to claim 21, Russell et al. discloses a device that is capable of having the support elements moved into an effective position before a working stroke of the drive begins.

As to claim 27, the device of Russell et al. is capable of being an integral part of a coiler.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russell et al.

Russell discloses the invention substantially as claimed except that a eccentrically mounted adjustment drive driven by a shaft (28) and handle (30) that extends parallel to the eccentric instead of a crank.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a crank instead of the drive adjustment of Russell et al. for the purpose of facilitating a users ability to turn the drive shaft because the examiner takes Official Notice of the equivalence of crank drive and adjust drive of Russell for their use in the drive adjustment art and the selection of any of these known equivalents to adjust the position of the blade would be within the level of ordinary skill in the art.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russell et al.

Russell et al. discloses the invention substantially as claimed including a chisel as one of the cutting tools mounted on one of the drums. Russell et al. lacks the other drum having a jacket area acting as an anvil. Russell et al. uses another chisel blade as the backup for the first chisel. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a chisel in combination with jacket area anvil instead of two chisels for the purpose preventing the need for accurate alignment between the upper and lower drums because the examiner takes Official Notice of the equivalence of multiple drums and chisels and anvil jackets in combination with a chisel for their use in the flying drum cutting art and the selection of any of these known equivalents to create multiple cuts in a workpiece would be within the level of ordinary skill in the art.

***Response to Arguments***

8. Applicant's arguments with respect to claims 14-21 and 27 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Boyer D. Ashley  
Primary Examiner  
Art Unit 3724

BDA  
May 3, 2004